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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/593,320	02/22/2007	Ian Arthur Burston	T2211-12006US01	7621

7590 07/21/2008

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EXAMINER	
BASINGER, SHERMAN D	
ART UNIT	PAPER NUMBER
3617	
MAIL DATE	DELIVERY MODE
07/21/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/593,320	BURSTON ET AL.	
	Examiner	Art Unit	
	SHERMAN D. BASINGER	3617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 June 2008*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,5-9 and 12-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2,5-9 and 12-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *18 September 2006* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 17 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 17 and 18 depend from canceled claim 3.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1, 2, 12-14, 5-7 and 19 are rejected under 35 U.S.C. 102(b) as being anticipated by Acker. Acker anticipates these claims as follows:

1. (Currently Amended) A floating water surface cover module 10 for a water storage tailings facility comprising a rim portion 16 and a cover portion 14, ~~means~~ a plurality of air-filled buoyancy pockets 22 spaced around the rim portion and associated with the rim and/or the cover portion for giving buoyancy to the module when in use such that the rim portion is substantially submerged in the water (see figure 2), said cover portion being configured to define an air space above the water when in use, said rim and/or cover portion being configured to allow the module to be nested within and

stacked with like modules for storage or transportation (see figures 4A and 4B) and each pocket 22 is configured to (claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language which does not limit a claim to a particular structure-MPEP 2111.04) nest in a corresponding indentation in the cover portion and/or rim portion of a like module when the modules are stacked and each pocket 22 in the cover and rim portions is an
open pocket adapted to be (claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language which does not limit a claim to a particular structure-MPEP 2111.04) closed by a lid fixed to the cover and rim portions to define a closed air-filled pocket.

19. (Currently Amended) A floating water surface cover module 10 for comprising a rim portion 16 and a cover portion 14, said cover portion 14 being configured to define when in
use an air space above the water (see figure 2) with the rim partially submerged in the water, a plurality of
air-filled buoyancy pockets 22 spaced around the rim portion and associated with the rim
and/or the cover portion for giving buoyancy to the module when in use, said rim and/or cover portion being configured to allow the module to be nested within and stacked with like modules for storage or transportation (figures 4A and 4B) and each pocket 22 is configured to (claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language which does not limit a claim to a particular structure-MPEP 2111.04) nest in a corresponding indentation in the cover portion and/or rim portion of a like module when the modules are stacked and each pocket 22 in the cover and rim portions is an open pocket adapted to be (claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language which does not limit a claim to a particular structure-MPEP 2111.04) closed by a lid fixed to the cover and rim portions to define a closed air-filled pocket.

The outwardly stepped formation of the rim portion of claim 2 is shown in figures 2, 7 and 8.

The vent of claim 6 is 26.

With regard to claim 7, see column 7, lines 26-30.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

6. Claims 8, 9, 15-18 and 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acker.

While Acker does not specifically disclose that the height (hr) of the rim and the depth (X)
of the freeboard portion satisfies the relationship:

o.1 ≤ x ≤ 0.3 (1), or that the diameter to height ratio of the rim (D:hr)
and the diameter to height ratio of the domed cover (D:hd) are between 5:1 and 25:1,

figures 2, 7 and 8 show that the height (hr) of the rim and the depth (X) of the freeboard portion nearly satisfies the relationship:

o.1 ≤ x ≤ 0.3 (1), and that the diameter to height ratio of the rim (D:hr) and the diameter to height ratio of the domed cover (D:hd) are nearly between 5:1 and 25:1.

To modify the dimensions of the module of Acker such that the height (hr) of the rim and the depth (X) of the freeboard portion satisfy the relationship:

o.1 ≤ x ≤ 0.3 (1), and that the diameter to height ratio of the rim (D:hr) and the diameter to height ratio of the domed cover (D:hd) are between 5:1 and 25:1 would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Motivation to make the above dimensional changes is to provide a solar heat collector which meets the requirements for use in a pool of a particular size.

Response to Arguments

7. Applicant's arguments filed June 19, 2008 have been fully considered but they are not persuasive. Applicant argues that Claims 1-7, 10-14, and 19 are rejected under 35 U.S.C. § 102(b) as being

anticipated by Acker ("Acker") (U.S. Patent No. 4,366,806). Applicants have amended

Claims 1 and 19, to incorporate the features of previous Claims 3 and 4 (both now

canceled), to overcome the rejection.

Regarding Claim 1, Claim 1 now recites:

"A floating water surface cover module for a water storage tailings facility comprising a rim portion and a cover portion, a plurality of air-filled buoyancy pockets spaced around the rim portion and associated with the rim and/or the cover portion for giving buoyancy to the module when in use such that the rim portion is substantially submerged in the water, said cover portion being configured to define an air space above the water when in use, said rim and/or cover portion being configured to allow the module to be nested within and stacked with like modules for storage or transportation and each pocket is configured to nest in a corresponding indentation in the cover portion and/or rim

portion of a like module when the modules are stacked and each pocket in the cover and rim portions is an open pocket adapted to be closed by a lid fixed to the cover and rim portions to define a closed air-filled pocket." (Underscore added by Applicants.)

Contrary to the Examiner's assertion, the buoyancy pockets denoted by reference numerals 22, 32 and 44 in Acker do not disclose the same air-filled buoyancy pockets as
recited in Claim 1. Specifically, Acker discloses a stackable soluble pool heater that is formed with a thin membrane cover for maximizing heat transfer through the membrane to underlying pool water to heat a pool. In fact, the membrane is so thin that reinforcing portions are required to prevent the membrane from collapsing. This is described in Acker in column 4, line 61 to 66, where the reinforcement is described as ribs or troughs 22 that "serve as stiffening means to aid the membrane in retaining and returning to the configuration illustrated" in Figures 3 and 6. However, nothing in Acker indicates that the ribs or troughs 22 provide any floatation capability. Rather, the solid pool heater incorporates foam strips 28 for flotation. The foam strips 28 and the troughs 22 do not comprise air-filled buoyancy pockets as recited in claims 1 and 19.
Also contrary to the Examiner's assertions, neither of channel 32 nor trough 44 are a closed air-filled pocket. Channel 32 is designed to take in water *(see,* Column 5, lines 45-
48) and trough 44 is merely an open trough that can trap air when inverted and placed on
the water that has partial or full ends to prevent any trapped air from escaping, but does not have a top to prevent air and/or water from entering and/or escaping *(see,* Column 6,
lines 10-13).

8. In rebuttal, troughs 22 of Acker anticipates the claimed air filled buoyancy pockets. Due to the open top of the troughs, they are air filled. Due to the nature of the design of the troughs they are capable of giving buoyancy to the module when in use. The troughs are much like the hull of a boat, ship or watercraft. The troughs will displace water and will weigh less than the water displaced such that they are capable of giving buoyancy to the module when in use. Note from MPEP 2114: While features of an apparatus may be recited either structurally or functionally, claims directed to an apparatus must be distinguished form the prior art in terms of structure rather than function. … A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Note that the limitation is that the pockets give buoyancy to the module when in use.

9. Applicant argues that the Examiner has incorrectly interpreted the limitations "each pocket is configured to nest in a corresponding indentation in the cover portion and/or rim portion of a like module when the modules are stacked" and "adapted to be closed by a lid fixed to the cover and rim portions to define a closed air-filled pocket" as merely intended use statements. In fact, each recitation positively recites actual additional structural characteristics of each pocket that are individually separate and apart from any possible intended use language that the Examiner may believe is present. Specifically, the pocket must be shaped in such a way as to nest in a corresponding indentation and include a lid that when closed creates the closed air-filled pocket. Nothing in Acker discloses either of these features of Claim 1.

10. In rebuttal, "configured to" and "adapted to" raise a question as to the limiting effect of the language in the claim. Claim scope is not limited by claim language that suggests or makes optional but does not require steps to be performed, or by claim language which does not limit a claim to a particular structure-MPEP 2111.04. In claims 1 and 19 "each pocket **is configured to** nest in a corresponding indentation in the cover portion and/or rim portion of a like module when the modules are stacked and each pocket in the cover and rim portions is an open pocket **adapted to** be closed by a lid fixed to the cover and rim portions to define a closed air-filled pocket" does not define any structure not anticipated by troughs 22 of Acker. Each of troughs 22 are open. Each of troughs 22 are capable of nesting in a corresponding pocket when the modules are stacked (stacking the modules without foam 28-figure 4B- would allow the troughs to nest within each other) or are capable of being closed by a lid fixed to the cover and rim if so desired. Note that applicant does not specifically claim a lid covering the pocket. Applicant only claims that the pocket can be closed by a lid. This is functional language and does not define any structure not anticipated by Acker.

11. Applicant concludes his arguments by stating that because Acker does not disclose all of the elements recited in Claim 1, the § 102(b) rejection of Claim 1 and Claims 2, 5-7 and 12-14 that depend therefrom, is believed to be overcome. Accordingly, Applicants respectfully request the Examiner to formally withdraw the Section 102 rejection of Claims 1, 2, 5-7 and 12-14.

Regarding Claim 19, which has been amended similar to Claim 1, for at least those reasons given above for Claim 1, because Acker does not disclose all of the

elements recited in Claim 19, the § 102(b) rejection of Claim 19 and Claims 20 and 21 that depend therefrom, is believed to be overcome. Accordingly, Applicants respectfully request the Examiner to formally withdraw the Section 102 rejection of Claims 1-21.

Claims 8, 9, 15-18, 20 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Acker. Applicants have amended Claims 1 and 19 to overcome the § 102(b) rejection, as noted above. Therefore, for at least those reasons given above for Claims 1 and 19, the Section 103 rejection of Claims 8, 9, 15-18, 20 and 21 is believed to
be overcome. Accordingly, the Examiner is respectfully requested to formally withdraw the section 103(a) rejection of Claims 8, 9, 15-18, 20 and 21.

12. In rebuttal, because Acker does disclose all of the elements recited in claim 1 (and claim 19), the rejections stand.

Conclusion

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sherman D. Basinger whose telephone number is 571-272-6679. The examiner can normally be reached on Monday through Thursday, 5:30 a.m. to 4:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Sherman Basinger/
Sherman Basinger
Art Unit 3617

Tuesday, July 22, 2008